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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/853,430

05/10/2001

Philip M. Ginsberg

CF/019

6761

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7590

12/18/2006

FISH & NEAVE IP GROUP

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EXAMINER

AKINTOLA, OLABODE

ART UNIT

PAPER NUMBER

3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/18/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/853,430

Applicant(s)

GINSBERG ET AL.

Examiner

Olabode Akintola

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-13 and 17-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-13 and 17-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/20/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4-7, 17-20, 27-28, 38-39 and 41-46 are rejected under 35 U.S.C. 102(b) as being anticipated by (Silverman et al (U.S. Patent No. 5136501) (hereinafter referred to as Silverman).

Re Claims 4, 17, 38 and 41- 46: Silverman teaches an apparatus and corresponding method comprising: determining whether execution of a pending trade between a first trader and a second trader would exceed a warning limit; executing the pending trade if the execution of the pending trade would not exceed the warning limit; and if execution of the pending trade would exceed the warning limit, processing the pending trade based on the specification of the first trader and a specification of the second trader, in which processing the pending trade results in one of a plurality of available outcomes including: all of the pending trade being executed, a portion of the pending trade being executed, and a rejection of the pending trade (col. 3, lines 18-38, col. 19, lines 3-8, col. 20, lines 26-28).

Art Unit: 3691

Re claims 5 and 18: Silverman teaches in which processing the pending trade comprises rejecting the pending trade when at least one of: the specification of the first trader comprises an indication to reject a pending trade when the pending trade would exceed a warning limit and the specification of the second trader comprises an indication to reject a pending trade when the pending trade would exceed a warning limit (col. 18, lines 33-35).

Re Claims 6, 19, 27 and 28: Silverman teaches in which processing the pending trade comprises executing a portion of the pending trade when the specification of the first trader and the specification of the second trader each comprises an indication to execute a portion of a pending trade when the pending trade would exceed a warning limit (col. 13, lines 16-24; Fig 18; col. 18, line 67 thru col. 19, line 7).

Re Claims 7 and 20: Silverman teaches in which processing the pending trade comprises executing a portion of the pending trade when the specification of the first trader comprises an indication to execute a portion of a pending trade when the pending trade would exceed a warning limit and the specification of the second trader comprises an indication to execute all of a pending trade when the pending trade would exceed a warning limit (col. 13, lines 16-24; Fig 18; col. 18, line 67 thru col. 19, line 7; col. 3, lines 18-38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8 –13 and 21-26, 29-37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman in view of Donner et al (EP 512702) (hereinafter referred to as Donner)

Re Claims 8 –13 and 21-26, 29-37 and 40: Silverman does not explicitly teach the step processing the pending trade comprises executing all of the pending trade when the specification of the first trader and the specification of the second trader each comprises an indication to execute all of a pending trade when the pending trade would exceed a warning limit. Donner teaches the step processing the pending trade comprises executing all of the pending trade when the specification of the first trader and the specification of the second trader each comprises an

indication to execute all of a pending trade when the pending trade would exceed a warning limit (page 9, line 52 thru page 10, line 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Silverman to include this step as taught by Donner. One would have been motivated to do this in order to allow the parties and/or counterparties to override the warning limit requirement, thereby enhancing the flexibility and effectiveness of the system.

Response to Arguments

Applicant's arguments filed 11/20/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Silverman does not teach, *"if execution of the pending trade would exceed the warning limit, processing the pending trade based on the specification of the first trader and a specification of the second trader, ... processing the pending trade results in one of a plurality of available outcomes including: all of the pending trade being executed, a portion of the pending trade being executed, and a rejection of the pending trade"*. Examiner respectfully disagrees. While the applicant admits that Silverman teaches *"a portion of the pending trade being executed"*, Examiner notes that Silverman also teaches *"a rejection of the pending trade"* (see col. 18, lines 30-35).

Also, Examiner interprets the step of setting/assigning the credit limit for counterparties (including zero credit limit) in Silverman as *"specification of the trader"*.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

A handwritten signature in black ink, appearing to read 'Hani M. Kazimi', is written over a horizontal line.

HANI M. KAZIMI
PRIMARY EXAMINER